

Appl. No. 09/929,599
Atty. Docket No. 8674
Amdt. dated August 11, 2003
Reply to Office Action of May 13, 2003
Customer No. 27752

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REMARKS

35 USC §102(b) rejection:

Claims 1, 6-16, 19, and 28-29 are rejected under 35 USC §102(b) as anticipated by Holden (US 3,284,285), hereinafter the '285 patent. A rejection under 35 USC §102(b) requires that the reference teach or suggest every aspect of the claimed invention. Any feature not taught must be inherently present (MPEP 706.02(a)).

Applicants respectfully submit that the '285 patent does not teach or suggest: a limiting orifice medium, pressing a web between a fluid permeable carrier and a limiting orifice medium, or the application of a vacuum to the pores of a limiting orifice medium in excess of the breakthrough pressure of the pores. Neither are these limitations inherent in the apparatus of the '285 patent.

The '285 patent does not teach or suggest a structure that is a limiting orifice medium. A limiting orifice medium is defined in US 5,274,930 (which patent is incorporated into Applicants' application by reference) as having a greater resistance to flow than the interstices between the fibers of the web being dried, and as being the component providing the greatest individual flow resistance to air flow (col.8 lines 44-49). The '285 patent does not teach or suggest a limiting orifice medium, therefore the patent does not teach or suggest that the web is pressed against a limiting orifice medium.

The '285 patent also fails to teach or suggest the application of a vacuum to the pores of a limiting orifice medium exceeding the breakthrough pressure of the pores. Contrariwise, the '285 patent teaches the application of a super-atmospheric pressure through the orifices of the porous cylinder and then to the web. The breakthrough pressure of the pores is expressed as a level of vacuum. The applied vacuum is a more negative pressure than the negative pressure corresponding to the breakthrough pressure. A super-atmospheric pressure is not a negative pressure.

The claimed limitations are not inherent in the disclosure of the '285 patent. Inherency requires that the claimed limitation necessarily occur from the intended acts of the reference. The porous cylinder of the '285 patent is not by necessity a limiting orifice medium. The intended acts of the '285 reference will not necessarily yield the application

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of a vacuum to the pores of a limiting orifice medium that is greater than the breakthrough pressure of the pores.

Rejection under 35 USC §103(a)

The Office Action rejects claims 2 and 21-22 under 35 USC §103(a) as being unpatentable over the '285 patent. Each of the rejected claims depends from a claim that Applicants submit is allowable in light of the remarks above and is therefore also allowable. Further, Applicants submit that the '285 patent is insufficient to establish a *prima facie* case of obviousness under 35 USC §103(a) because the reference does not teach each of the claimed limitations as detailed above.

The Office Action rejects claims 3-5, 17-18, and 20 under 35 USC §103(a) in view of Holden (the '285 patent) and Ensign (US 4,584,126) hereinafter the '126 patent. Each of the above listed claims depends from a claim that Applicants submit is allowable in light of the remarks above and is therefore also allowable.

Applicants further submit that the combination of references fails to establish a *prima facie* case of obviousness under 35 USC §103(a) because the combination of references does not teach or suggest each of the claimed limitations, a person of ordinary skill in the art would have no expectation of success in making such a combination, and there is no motivation to combine the references other than the Applicants invention.

The combination of references fails to teach the pressing of a web against a limiting orifice medium. The '285 patent does not teach this limitation and the addition of the '126 patent does not cure this deficiency.

The references, taken each as a whole, cannot be combined with any expectation of success. The combination of the references yields a contradictory drying apparatus that teaches the simultaneous application of a super-atmospheric pressure and a vacuum to the same surface of a porous medium. The combination also yields the contradictory position of attempting to pull water into a porous medium using capillary action and vacuum applied through the pores while simultaneously forcing high pressure gas through the capillary pores in the direction opposed to the capillary and vacuum induced fluid flow.

There is no permissible motivation for combining the references. The '285 patent teaches the drying of an embryonic web through the application of a super-atmospheric

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Respectfully submitted,

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August 11, 2003

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pressure to the web through a porous cylinder and mechanically pressing the web. The '126 patent teaches the application of varying levels of vacuum to the web through a limiting orifice medium. The teaching of each reference must be considered as a whole. Therefore there is no motivation to combine the teachings of the '285 patent and the '126 patent since one dries a web using a positive pressure and the other dries using a negative pressure together with capillary action.

The only motivation for combining selective portions of the respective references is the invention submitted by the Applicants. The combination represents an impermissible combination of selective portions of two references, made in hindsight, while neglecting to consider the teachings of each reference as a whole. The rejection based upon this combination should be reconsidered and withdrawn.

Rejection under 35 USC §112:

The Office Action rejects claims 3-5 under 35 USC §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants consider as the invention. Specifically, the claims are rejected for failing to provide sufficient antecedent basis for the limitation "capillary pores".

Claim 3 has been amended to provide sufficient antecedent basis for the limitation "capillary pores". Claims 4 and 5 depend from claim 3. This rejection has been overcome by the amendment and should be reconsidered and withdrawn.

Allowed claims:

Applicants gratefully acknowledge the Examiner's indication that claims 23-27 are allowable. The withdrawal of the 35 USC §§102(b), 103(a), and 112 rejections would therefore render all the claims allowable.

In light of the submitted amendment and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejections under 35 USC §§102(b), §103(a) and 112. Early and favorable action in the case is respectfully requested.